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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,660	07/12/2001	Valerie Jeanne-Rose	05725.0926-00	2004

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,660

Applicant(s)

JEANNE-ROSE ET AL.

Examiner

JYOTHSNA A VENKAT

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8,9 and 25-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,10-24 and 38-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of declaration, IDS, request for correcting PGPUB, extension of time and election filed on 10/23/01, 6/11/02 and 12/2/02.

Election/Restrictions

1. Applicant's election with traverse of Group II in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the office has failed to establish that a search and examination of the groups I-XVI will constitute serious burden. This is not found persuasive because as stated and explained detailed in paper no.9, the search between the groups I-XVI is indeed serious burden. Applicant's attention is drawn to pages 6-12 which explains the reason for the groups being distinct. Applicants also traverse the restriction between the species and argue that the office has failed to establish that a search and examination of the species would constitute serious burden. This is not found persuasive. The species are distinct for the reason stated at pages 13-14 of paper no.5.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5-6, 8-9 and 25-37 are not drawn to elected group. Claims 5-6 are drawn to group III and claims 8-9 are drawn to groups which has the ligand and claim 9 is drawn to groups which has Z moiety and claims 25-37 are drawn to groups which has the moiety X. ***Therefore claims 5-6, 8-9 and 25-37 are withdrawn from consideration as being drawn to non-elected invention.***

Claims 1-4, 7, 10-24 and 38-49 will be examined to the extent that it reads on the elected group where in the metal precursor is formula Ib and the metal M is silicon.

Claim Rejections - 35 USC § 112

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2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 10-24 and 38-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to silicon covalently bonded to three oxygen atoms and one R group which is "**cosmetically active group**". The specification defines at paragraph bridging pages 7-8 as the following. The group can be colorant group. There is no structure given to this colorant group. **The specification gives no guidance to one of ordinary skill in the art the attachment of this colorant to the silicon atom.** The next choice is a photo chromic group. The specification does not define the compound in this category. The same is true for all the choices recited at page 8. The specification defines one of the choice as "*group for promoting adhesion to keratin materials such as amide, urethane, urea, hydroxyl, carboxyl, amino acid or polypeptide group*". Note all the groups recited for this Choices are functional groups. The functional groups includes plethora of compounds which has this functional moieties.

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The expression “cosmetically active group” without i.e. partial or complete structure does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter. The functional language recited without any correlation does not meet the written description requirement for the expression cosmetically active group as one of ordinary skill in the art could not recognize or understand the structure from the mere recitation of the function. Claims employing functional language at the point of novelty, such as applicants’, neither provide those elements required to practice the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only **an invitation to experiment** regarding possible compounds.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4, 7, 10-24 and 38-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

I. Claims 1, 45 and 48 recite “**cosmetically active group**” for the definition of R. Note that the formula IB is drawn to covalent structure. The metal is silicon and the silicon has three oxygen atoms. When the fourth bond is cosmetically active group the expression lacks precision and clarity. How is this “**cosmetically active group**” linked to the central silicon atom by covalent bond? The various groups recited are drawn to divergent compounds. Applicants are requested to

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show the reaction in such way that, in group Ib **the cosmetically active group is covalently linked to silicon**. Due to these reasons, it is the examiners position that the claims lack clarity and precision.

II. The expression “ **cosmetically active group**” is without metes and bounds for the various choices recited in the Markush format. The specification at page 8 recites the same groups claimed in claims 1,45 and 48. The metes and bounds of this claim can not be determined from mere recitation of “ colorant group ----- and a vitamin bearing group”. Since the metes and bounds of this phrase can not be determined from the disclosure, the claim lacks clarity.

III. Regarding claims 1, 45 and 48, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

IV. The expression “ containing “ for the definition R₁ in claims 1,45 and 48 lacks clarity because the meaning of “ containing “ is same as “ comprising”. Applicants are defining carbon chain length using the phrase “ containing” . this expression also includes carbon chain outside the scope of claims. Deletion is suggested to overcome the above rejection. The same is true for claim 3.

V. The expression “ “ interrupted and substituted “ with 1 to 20 heteroatoms chosen from O, N, S and P” is without metes and bounds. Proper support in the specification for the categories” interrupted” and substituted” would be given careful consideration. What specific phosphorous moieties are contemplated?

VI. Claim 7 lacks clarity without the definition R₂ and R₃. The metes and bounds of both the R groups can not be determined from the specification. The specification indeed defines R₂ when it

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is part of the non-elected group R'' . there is no definition for R_3 in the specification and the claim therefore lacks clarity.

VII. What is meant by treating Mascara in claim 46? Mascara is a product applied to eyelashes. Therefore the claim lacks clarity.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 4, 7 10-14, 19-24, 38-46 and 48-49 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0,159,628 ('628).

See page 3 for the structure. See page 4 for the definition of variables . see page 5, which anticipates claim 2. Claim 7 is also anticipated by the reference where in R is C_1 - C_{18} hydrocarbon radical substituted with amino and urea groups. Claims 10-14 are inherent absence of evidence to the contrary. See page 4 for the concentration of the active ingredient which anticipates claims 39-43. Claim 44 is met by the structure in the reference. Claim 46 is drawn to composition and therefore claim 46 is also anticipated by the reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '628.

The instant application is claiming composition comprising one metallic compound obtained from the metal precursor of formula Ib where in the composition is in the form of lotion, mousse, styling spray, styling stick and styling lacquer.

The EP patent '628 teaches hair strengthening and permanent waving compositions using the formula Ib. See the relevant pages outlined in 102 rejection. The patent does not teach the limitation of claim 47. However hair products are formulated in the forms claimed in the instant application.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '628 and prepare the compositions in the various forms, expecting beneficial effect to the hair. It is known in the art to pack the hair products in the form of lotion, sprays, and mousse. This is a prima facie case of obviousness.

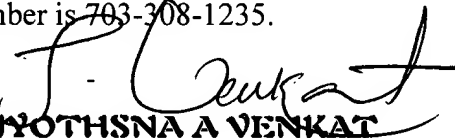
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-

2439. The examiner can normally be reached on M-F; 9:30-6:30: 1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615

February 5, 2003